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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/354,608	07/16/1999	YASUHIRO YAMANAKA	SONYJP-3.0-0	5368
530	7590	08/19/2004	EXAMINER	
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			ABDI, KAMBIZ	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 08/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/354,608

Applicant(s)

YAMANAKA, YASUHIRO

Examiner

Kambiz Abdi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 28-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 28-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this section can be found in the prior office action.

2. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.

- Claims 1, 2, 4, 5, 7, 28, 34, 36, 39, 40, 46, 48, 51, and 64 are amended.
- Claims 10-27 have been cancelled.
- Claims 52-64 have been added.
- Claims 1-9 and 28-65 are pending.

### ***Response to Arguments***

3. Applicant's arguments filed 9 April 2004 have been fully considered but they are not persuasive. In addition, applicant's arguments are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-9 and 28-65 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. US 2001/0032187 A1 to Xavier Nuttall in view of US Patent Application Publication No. US 2002/0029380 A1 to Kenji Matsumoto et al.

6. Regarding claims 1, 6, 55, 60 and 64:

Nuttall teaches a method for computer network operation providing basis for usage fees such that Applicant's copyright information storage means for storing copyright information related to the copyrighted works, said copyright information including the identities of the

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copyrighted works, the identities of the owners of the copyrights for the copyrighted works and data related to the costs for downloading the copyrighted works at said receiving side **reads on** content providing node, element 108 and figure 14,

Applicant's receiving means for receiving downloading information sent from the receiving side, said downloading information identifying selected copyrighted works distributed from the distribution side and downloaded at said receiving side, indicating that said receiving side's downloading of said selected copyrighted works was authorized, and indicating that an accounting has occurred for said receiving side's payment for said downloading **reads on** authorizing node, element 112, content requesting node, element 110 and the permit, column 4, lines 16 – 22,

and Applicant's copyright management means for performing copyright management related to the copyright for each selected copyrighted work in response to said downloading information and based upon said downloading information and the copyright information, said copyright management including calculating a copyright payment due each owner of the copyrights for the selected copyrighted works **reads on** reconciling node, element 118.

What Nuttall is silent on is the fact that a removable secondary memory such as an IC card or a smart card can be used on the receiver side to store all the pertinent information regarding the purchased copyrighted material. However Matsumoto clearly teaches the utility and incorporation of the IC card or the smart card as part of the computerized system and method of purchasing televised programming such as video, games or music over a network communications, as a secondary memory to store the information such as funds, transaction conditions, or contract conditions as well as updating the information within the storage medium based on the transaction and storing such transaction information on the smart card rather than a hard drive as it is apparent in the Nuttall system, Matsumoto paragraphs [009], [0011], [0024], and [0040]. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Nuttall to include the secondary memory as a smart card to be able to make the system more transportable as well as more secure of the individual users.

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7. Regarding claims 4-5 and 58-59:

Applicant's customer management center reads on authorizing node 112, page 2, paragraph [0035].

8. Regarding claims 7, 38, 50 and 61:

Nuttall teaches that the content is encrypted, step 1210 of figure 12. See also page 4, paragraph [0051].

9. Regarding claims 8 and 62:

Nuttall discloses using satellite communications.

10. Regarding claims 9, 37, 49 and 63:

Nuttall discloses that the content/work can be music, page 3, paragraph [0038].

11. Regarding claims 28, 29, 36, 40, 41 and 48:

Applicant's server adapted to serve said copyrighted works through a first transmission system to a receiving facility **reads on** the content providing node 108 and element 148.

Applicant's communication interface adapted to receive through a second transmission system downloading information, said downloading information identifying selected copyrighted works downloaded by said receiving facility, indicating that said receiving facility's downloading of said selected copyrighted works was authorized and indicating that an accounting has occurred for said receiving facility's payment for said downloading **reads on** content providing node, element 108 and 136, authorizing node, element 112, content requesting node, element 110 and the permit, column 4, lines 16 – 22,

Applicant's memory adapted to store copyright information corresponding to each of said copyrighted works, said information providing the identity of the copyrighted work, the identity of the owner of the copyright for the copyrighted work and data relating to the cost for downloading the copyrighted work by said receiving facility **reads on** the various reports generated by the nodes and stored in memory, figures 17 - 20, and

Applicant's processor, in communication with said memory and said communication interface, adapted to calculate, in response to said downloading information and on the basis of said downloading information and said copyright information, a copyright payment due each

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owner of the copyrights for the selected copyrighted works **reads on** reconciling node, element 118.

What Nuttall is silent on is the fact that a removable secondary memory such as an IC card or a smart card can be used on the receiver side to store all the pertinent information regarding the purchased copyrighted material. However Matsumoto clearly teaches the utility and incorporation of the IC card or the smart card as part of the computerized system and method of purchasing televised programming such as video, games or music over a network communications, as a secondary memory to store the information such as funds, transaction conditions, or contract conditions as well as updating the information within the storage medium based on the transaction and storing such transaction information on the smart card rather than a hard drive as it is apparent in the Nuttall system, Matsumoto paragraphs [009], [0011], [0024], and [0040]. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Nuttall to include the secondary memory as a smart card to be able to make the system more transportable as well as more secure of the individual users.

12. Regarding claims 39 and 51:

See pages 2 - 3, paragraph [0035].

13. Regarding claims 30 and 42:

Although Nuttall does not specifically teach that the content providing node, element 108 (server) serves through a first transmission system and the content providing node, element 108 (communication interface) receives through a second transmission system, Nuttall does disclose that Satellite communications is possible. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to, for instance, receive a request for content via the internet, from a user, and for the content provider to provide the content (video) via a satellite transmission system as this method is old and well known and Nuttall discloses that satellite communication is one possible method, page 2, paragraph [0029].

14. Regarding claims 31 and 43:

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While Nuttall does not specifically disclose a copyright fee "ratio", it is considered that it would have been obvious, if not inherent, to use a fee "ratio" as most fees/costs are based on some type of profit margin which can be illustrated as a ratio.

15. Regarding claims 52-54 and 65:

While Nuttall does not specifically disclose the usage of the removable memory card, however, Matsumoto clearly teaches the usage of the memory cards such as IC cards or smart card, Matsumoto paragraphs [009], [0011], [0024], and [0040]. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Nuttall to include the secondary memory as a smart card to be able to make the system more transportable as well as more secure of the individual users.

16. Claims 2, 3, 32 – 35, 44 – 47, and 56-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nuttall in view of US Patent Application Publication No. US 2002/0029380 A1 to Kenji Matsumoto et al. as applied above, and further in view of U.S. Patent No. 6,388,714 to Steve M. Schein et al.

17. Regarding Claims 2, 3, 32 – 35, 44 – 47, and 56-57:

While Nuttall does not specifically disclose how video content may be selected by a user, Schein et al teach video content ordering wherein Applicant's program identification information, where said program identification information including the identity of a television program featuring broadcasted copyrighted works transmitted from said distribution side, the identities of said broadcasted copyrighted works, a broadcasting time for said television program and the identities of channels on which said broadcasted copyrighted works are transmitted, and wherein said copyright management means also performs said copyright management based upon said program identification information is taught. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Nuttall to include television programs as a content selection, as taught by Schein et al, as Nuttall does disclose

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video transmission capability, and including television programs would only increase the profits to be earned by Nuttall's content provider.

18. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

#### ***Conclusion***

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

20. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks  
Washington D.C. 20231**

or faxed to:

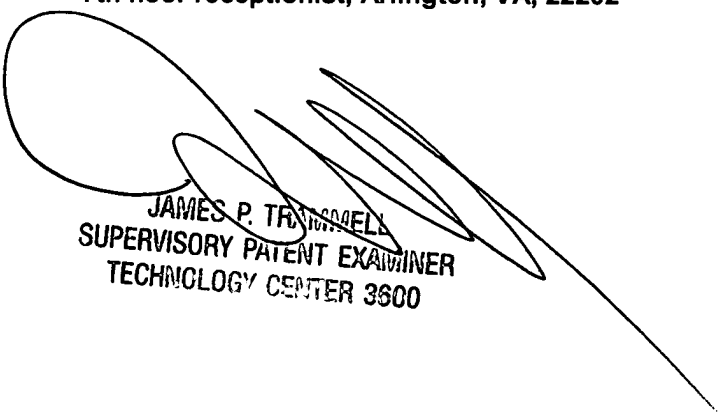
(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

**Crystal Park 5, 2451 Crystal Drive  
7th floor receptionist, Arlington, VA, 22202**

**Abdi/K  
August 12, 2004**



**JAMES P. TRIMMELL  
SUPERVISORY PATENT EXAMINER  
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